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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,446	09/29/1999	HITOSHI TERASHIMA	64246RCE	2769

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SCARBOROUGH, NY 10510-9227

EXAMINER
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NGUYEN, MADELEINE ANH VINH

ART UNIT	PAPER NUMBER
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2625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/407,446

Applicant(s)

TERASHIMA ET AL.

Examiner

Madeleine AV Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 34-39, 41, 45, 46, 48-52, 54, 56-65 and 67-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-39, 41, 45, 46, 48-52, 54, 56-65 and 67-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                  |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                             | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/31/06</u> . | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on October 18, 2006 have been fully considered but they are not persuasive.

Applicant remarks that Tajima fails to teach or suggest the combination of a scanner that includes a roller driven by a motor within the scanner. Applicant also remarks that the motor 54 in Tajima is a rotary encoder and not a motor. The roller driven by a motor in the present invention is significant because it advantageously allows the scanner to move autonomously when it is detached from the image forming apparatus so that a user does not have to physically move the scanner.

First, Tajima teaches that when the scanner 2 is mounted on the image forming apparatus 1, it transports a sheet by the rollers 20 and 21 while scanning. It is noted that the belt connecting the motor 54 and roller 21 in Fig.5 help the roller moves when the motor 54 moves. Even if Applicant does not agree that element 54 is a motor which guide the rollers, there must have a motor to guide the roller 20 or 21 to transport the original sheet. From Figs. 1, 2 and 5, we can see that the original sheet is guided by the roller in the scanner 2 by the arrows pointing down. How can a roller transport an original sheet without a presence of a motor. If the roller driven by a motor in the scanner 2 can transport a sheet when mounted on the image forming apparatus 1 by itself, it can guide the scanner, not mounted on the image forming apparatus 1, to read an original sheet. Moreover, it is a matter of well known in the art at the time the invention was made to have a hand-held scanner not attached to any apparatus having rollers driven by a

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motor. Kochis et al (US Patent No. 5,381,020) discloses a hand-held scanner (Figs. 2, 5) comprising a drive roller assembly 30, 32, 40, 42, etc. mounted on the scanner housing 12 to be rollingly displaced across an object 11 in a predetermined scan direction 13. A motor 50 is drivingly linked to the drive rollers 30, 32, etc. for applying driving torque and a control assembly actuates the motor 50 for angularly accelerating and decelerating the drive rollers within a predetermined speed range (col. 3, lines 23-36; col. 5, lines 1-4). Thus it would have been obvious to one skilled in the art at the time the invention was made as a matter of well known in the prior art to consider the scanner 2 in Tajima having a motor for driving roller in order to transport the original sheet for scanning since Tajima teaches that the scanner 3 transports the original sheet when scanning (Fig.5).

In addition, Applicant argues limitation that is not in the claims. There is no limitation in the claim that, when the scanner is detached from the image forming apparatus, the roller driven by a motor in order for the scanner to move **autonomously** so that a user does not have to physically move the scanner. Even if that limitation is stated in the specification, it is noted that the specification is not the measure of the invention. Therefore, limitations contains therein cannot be read into the claims for the purpose of avoiding the prior art. In re Sporck, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968).

Last, clarification is needed on whether, when the scanner is detached from the image forming apparatus, the roller driven by the motor move the scanner in order to read the original sheet or the roller driven by the motor move the document in order for the scanner to read the original since from the remark on page 14, Applicant states, "the roller driven by a motor in the present invention is significant because it advantageously allows the scanner to move

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autonomously when it is detached from the image forming apparatus ...” while on page 15, Applicant states, “With this construction the sheets of paper can move through the scanner at all times with or without the scanner being attached to the printer.”

Therefore, the rejection of claims 34-39, 41, 45, 46, 48-52, 54, 56-65 and 67-73 is maintained.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 34-39, 41, 45-46, 48-52, 54, 56-65 and 67-73 rejected under 35 U.S.C. 102(b) as being anticipated by Tajima (Japanese Publication Number 03003030 A).

Concerning claims 34, 46, 49, 50, 52, Tajima discloses an apparatus (1) comprising an image forming apparatus (3), and a scanner (2) which is removable mounted on the image forming apparatus (3) and includes a reading element (2a), a motor (54) and a roller (21) driven by the motor (54); wherein the motor drives the roller to transports a sheet with the scanner mounted on the image forming apparatus (Figs.2, 5) and the scanner reads an original guided by the roller driven by the motor with the scanner detached from the image forming apparatus ((Fig.1) and a first sheet transporting path (5, 6) is formed substantially vertically to guide a sheet downward on the first sheet transporting path and the reading element reads the sheet in a case where the scanner is mounted on the image forming apparatus, and the image forming apparatus

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includes a second sheet transporting path (3a, 3b) extending substantially vertically to guide a sheet downward on the second sheet transporting path, the image forming apparatus performs an image forming process for a sheet traveling along the second sheet transporting path; and the first sheet transporting path and the second sheet transporting path are arranged adjacent each other (Figs.1, 5).

It is noted that Tajima teaches in Figs 2 and 5 that the scanner with roller 20 and 21 transports the original sheet for scanning, a motor for driving the rollers is inherently taught in order for the rollers to transport the original sheet. Thus, even when the scanner is detached from the image forming apparatus, the rollers driven by the motor can guide to scanner to scan an original sheet as shown in Fig.1.

Concerning claims 35-38, 41, 45, 48, 51, 59, 60, 61, 62, 63, 64, 67-73, Tajima further teaches that a surface of the scanner on which the reading element is provided faces toward the image forming apparatus in case where the scanner is mounted on the image processing apparatus so that a sheet transporting path is made between a surface of the image forming apparatus and the surface of the scanner (Fig.1), (claims 35, 41, 62); the image forming apparatus a printer (Abstract), (claims 36, 48); the moving direction of a first sheet that moves on the first sheet transporting path moves in the same direction as the moving direction of a second sheet that moves on the second sheet transporting path, (the arrows shown in Figs. 1 and 2), (claim 37); a projecting member is provided on the surface of the scanner for projecting the roller in a case where the scanner runs independent of the image forming apparatus (Figs.5-6), (claims 38, 61, 70); a projecting member is provided on the surface of the scanner for protecting the roller in a case where the scanner runs by itself (Figs.5-6), (claim 45); the roller of the scanner

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apparatus is a pick roller, and the apparatus has a sheet separating member faced to the pick roller in a case where the scanner apparatus is mounted on the image forming apparatus (Figs.5-6), (claims 51, 63, 72); a first sheet transporting path (5-6) is formed substantially vertically to allow the reading element (2) to read the sheet in a case where the scanner is mounted on the base, the base include a second sheet transporting path (3a-3b) extending substantially vertically, the base performs a processing for a sheet traveling along the second sheet transporting path, the first sheet transporting path being arranged along the second sheet transporting path (Figs.1, 2, 5), (claims 59, 67, 68); the scanner has a motor (54) the motor actuates the roller (21) and thereby transports a sheet in a case where the scanner is mounted on the base unit, so that the reading element reads the sheet, and the motor actuates the roller (Figs.5-6), (claim 60); the base unit is an image forming apparatus (printer), (claims 64, 69, 73); .

Concerning claims 39, 58, 67, 71, Tajima discloses the apparatus as discussed in claim 34 wherein the motor actuates the roller to transport a sheet in a case where the scanner is mounted on the image forming apparatus and the scanner reads an original guided by the roller driven by the motor in a case where the scanner is detached from the image forming apparatus; and wherein a surface of the scanner on which the reading element is provided faces toward the image forming apparatus in case where the scanner is mounted on the image processing apparatus so that a sheet transporting path is made between a surface of the image forming apparatus and the surface of the scanner (Fig.1).

Concerning claim 54, Tajima teaches a first unit (scanner 2) which is capable of being removable mounted on a second unit (1) as discussed in claim 34 above.

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Concerning claims 56-57, Tajima discloses an apparatus as discussed in claim 34 above and further comprising a base unit including a sheet accommodating part accommodating a plurality of sheets wherein the sheet accommodating part accommodates the plurality of sheets in a substantially vertical direction (input and output 5-6, 3a-3b).

Concerning claim 65, Tajima discloses a scanner apparatus as discussed in claim 34 above. Tajima further teaches that in a case where the scanner is detached from the base unit, the reading element reads the sheet while the roller travels the scanner with self-running on an original (Figs.2, 5).

### ***Conclusion***

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

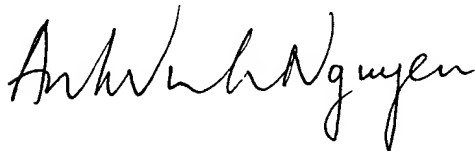


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 571 272-7466. The examiner can normally be reached on Tuesday-Thursday 12:30-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 571 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'Madeleine AV Nguyen', is written in a cursive style.

Madeleine AV Nguyen  
Primary Examiner  
Art Unit 2625

January 18, 2007